

**REMARKS**

Claims 1, 3-7, and 9-16 are all the claims pending in the application.

Claim 1 has been amended to correct an oversight effected when the claim was transcribed from the marked-up version at page 8 to the clean version at page 1 of the Amendment filed October 21, 2002.

Referring to claim 3, the amendment thereto does not narrow its scope. The term "phyllosilicate" is the name of the silicate sub-family that has a layered structure. As such, it may be considered interchangeable with the phrase "silicate of layered structure."

At paragraph No. 2 (page 2) of the Action, the Examiner makes a pair of objections. The first objection has been resolved by the correction to claim 1, noted above. As for the second objection, Applicants respectfully traverse.

The objection relates to the assertion that the Markush groups of claims 9 and 11 overlap, insofar as they both recite polyurethanes and polyesters. The Examiner asserts that because claim 11 is not further limiting of claim 9, the claims are essentially duplicates when the organic compound is either polyester or polyurethane.

Applicants respectfully disagree.

The question of whether a claim "further limits" another claim stems from the fourth paragraph of §112, and is not at all related to the present instance, wherein claims 9 and 11 each depend from claim 1 (claim 11 does not depend from claim 9). The test for a proper dependent claim under the fourth paragraph of §112 is whether the dependent claim includes every limitation of the claim from which it depends. The test is not one of whether the claims differ in scope.

Each claim in an application, moreover, must be looked at as a whole. Present claims 9 and 11, viewed as a whole, are two claims of different scope, and the fact that there's some overlap in their Markush groups is not improper. The specification (at page 3, lines 19-28 and

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page 4, lines 8-13) describes the difference between the scopes of claims 9 and 11. Claim 9 relates to material which may be used as a protective coating, whereas claim 11 relates to liquid polymers. There is no basis for this objection, and Applicants request its withdrawal.

Amended claim 3 satisfies each of the requirements of §112.

At paragraph No. 6 (page 3) of the Action, claims 1, 3-7, and 9-16 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 5,173,960 to Dickinson ("Dickinson") in view of U.S. Patent No. 6,190,775 to Smith, *et al.* ("Smith").

Applicants respectfully traverse.

The basis for a rejection under § 103 cannot rely on picking and choosing different elements or aspects of the references (*see*, Smithkline Diagnostics v. Helena Laboratories Corp., 8 USPQ2d 1468, 1475 (Fed. Cir. 1988)). There must be a "clear and particular" suggestion to modify the prior art and arrive at the claimed invention (*see*, In re Sang Su Lee, 2002 U.S. App. LEXIS 855 (Fed. Cir. 2002); Winner Int'l Royalty Corp. v. Ching-Rong Wang, 53 USPQ2d 1580, 1586-1587 (Fed. Cir. 2000)).

These axioms are especially applicable to a case such as the present one where Smith discloses nanoclays among many different materials.

Furthermore, Smith's disclosure is limited to the existence of nanoclays that may contain intercalated polymers between the platelets. Smith never suggests to put this material in a polymer matrix to make a covering layer.

Still further, the combination of Dickinson and Smith cannot lead a person of ordinary skill in the art to arrive at the present invention because the substitution of one of the inorganic oxide constituents of Dickinson by the mica tape of Smith gives a result which is clearly different from the present invention.

In addition, Applicants are in the process of obtaining and will be submitting a sworn translation of the French priority document (FR 9905764) in order to disqualify Smith from

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being valid §102(e) prior art against the present application. The priority document satisfies each of the requirements of §112, first paragraph, for the full scope of the present claims.

If the Examiner has not received the sworn translation of the priority document by the time the present case is taken up for action, Applicants kindly request that the Examiner telephone the undersigned at the direct telephone line indicated below.

Reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, she is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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PATENT TRADEMARK OFFICE

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**APPENDIX**

**VERSION WITH MARKINGS TO SHOW CHANGES MADE**

**IN THE CLAIMS:**

**The claims are amended as follows:**

1. (THRICE AMENDED) A cable comprising at least one optical fiber and at least one covering layer comprising a composite material, wherein:

said composite material is in the form of particles, and said particles have a size of nanometer order and include an organic compound and an inorganic compound;

said inorganic compound (i) is graphite or an inorganic oxide, (ii) has a layered structure, and (iii) has been treated to allow said organic compound to be inserted between the layers of said inorganic compound; and

said organic compound is selected from the group consisting of polymers, monomers, and oligomers, and is inserted between the layers of said inorganic compound.

3. (TWICE AMENDED) A cable according to claim 1, in which said inorganic oxide is selected from the group consisting of a metal oxide of layered structure and a silicate of layered structure ~~or "phyllosilicate"~~.